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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/558,329	04/25/2000	Randolph A. Stern	STAN-09RE	9722

26875 7590 08/05/2005

WOOD, HERRON & EVANS, LLP  
2700 CAREW TOWER  
441 VINE STREET  
CINCINNATI, OH 45202

EXAMINER

JUSKA, CHERYL ANN

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 08/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/558,329	Applicant(s) STERN ET AL.	
	Examiner Cheryl Juska	Art Unit 1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 May 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-87 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-87 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Continued Examination Under 37 CFR 1.114*

1. A request for continued examination under 37 CFR 1.114 was filed in this application after a decision by the Board of Patent Appeals and Interferences, but before the filing of a Notice of Appeal to the Court of Appeals for the Federal Circuit or the commencement of a civil action. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114.

### *Response to Amendment*

2. Applicant's amendment filed with said RCE has been entered. Claims 1, 11, 12, 22, 23, 30, 39, 51, 58, 65, 70, and 80 have been amended as requested.

3. Said RCE is filed in response to the Board's Decision on Appeal mailed January 19, 2005. In said Decision, the Board reversed the 112, 1<sup>st</sup> rejection. As such, said rejection is hereby withdrawn. However, the Board affirmed all of the standing prior art rejections. Said affirmation was based upon the examiner's proper interpretation of the claim recitation "yarn face." (Decision, pages 9-11.) Specifically, the Board affirmed that said recitation of "yarn face" did not limit said yarn face to being "effectively continuous such that the felt is not generally exposed." In response to said Board Decision, applicant has amended the independent claims to include the limitation "wherein each yarn face is effectively continuous such that the corresponding web surface is not generally exposed at the associated yarn face." However, said

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amendment is insufficient to overcome said rejections for the reasons set forth in the Examiner's Answer, page 26, 1<sup>st</sup> paragraph.

4. To reiterate, the new limitation is a relative, subjective description of the yarn face. How continuous is "effectively continuous?" How much exposure is allowed with "not generally exposed?" Regarding the amount of exposure, the specification says 'small gaps or interstices between adjacent yarn segments may allow viewing of the felt surface upon close inspection' (col. 2, lines 59-63). How small are the "small gaps or interstices?" How close is the "close inspection?" The specification, as originally disclosed, provides no *objective or qualitative* instruction as to what quantifies as "effectively continuous such that the corresponding web surface is not generally exposed at the associated yarn face." There is no mention of suitable stitch yarn deniers or diameters, stitch sizes, or even stitch densities, which would guide one skilled in the art as to the scope of 'an effectively continuous yarn face.' A relative description cannot be relied upon for distinguishing the present invention from the prior art. Further arguments are presented below with respect to the specific art references.

### *Claim Rejections - 35 USC § 102*

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 65 and 67-69 stand rejected under 35 U.S.C. 102(b) as being anticipated by US Patent 4,026,129 issued to Sternlieb, as set forth in section II, page 5 of the Examiner's Answer.

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Applicant traverses the Sternlieb rejection by asserting that the reference requires the scrim layer to being exposed, which is contrary to the presently claimed invention (Amendment, pages 24-25). This argument is unpersuasive since the amount of exposure claimed by applicant is merely a relative description and not a specified quantitative amount. It is believed that the Sternlieb teaching meets the relative degree of exposure claimed. Therefore, the above rejection is maintained.

7. Claims 30-37 and 51-64 are rejected under 35 U.S.C. 102(b) as being anticipated by US 4,181,514 issued to Lefkowitz et al., as set forth in section III, page 5 of the Examiner's Answer.

Applicant traverses the above Lefkowitz rejection by asserting the metal stitch yarns of the reference would prevent the stitches of the filter medium from being "effectively continuous" (Amendment, page 25). This argument is also unpersuasive since applicant's claim limitation is of a relative nature. It is argued that the Lefkowitz reference meets applicant's relative degree of exposure despite its requirement of being a filter medium. Therefore, the above rejection is maintained.

8. Claims 1, 3-9, 12, 14-20, 30, 32-38, 51, 53-56, 58, 59, 61-66, 68, and 69 are rejected under 35 U.S.C. 102(b) as being anticipated by US 4,675,226 issued to Ott, as set forth in section IV, page 6 of the Examiner's Answer.

Applicant traverses the Ott rejection by asserting the disclosed stitch density is "very low" and "not consistent" with applicant's "effectively continuous yarn face" (Amendment, page 26). In response, it is reiterated that applicant has not disclosed any specific stitch density. Without a quantitative stitch density to compare the prior art to, it is unclear how applicant can come to the conclusion that the stitch density of said prior art is inconsistent with the presently

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claimed invention. Once again, it is argued that the feature which applicant relies upon is a relative limitation which cannot be employed to distinguish the present invention from the prior art. Therefore, the above rejection is maintained.

9. Claims 30, 32-36, 39, 41, 42, 46-51, 53-56, 65, 68, 69, 80, 83, 84, 86, and 87 are rejected under 35 U.S.C. 102(b) as being anticipated by US 5,356,402 issued to Gillies et al., as set forth in section V, page 7 of the Examiner's Answer.

Applicant traverses the Gillies rejection by asserting the disclosed stitch density is low and necessarily produces large open gaps rather than the presently claimed "effectively continuous face" (Amendment, page 27). An argument comparing a given stitch density in the prior art to no teaching or suggestion of a stitch density in the present invention is not very convincing.

Again, it is argued that the feature which applicant relies upon is a relative limitation which cannot be employed to distinguish the present invention from the prior art. Therefore, the above rejection is maintained.

### *Claim Rejections - 35 USC § 103*

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 2, 10, 11, 13, 21, 22, 31, 52, 57, 60, and 67 are rejected under 35 USC 103(a) as being unpatentable over the cited Ott patent, as set forth in section VI, page 7 of the Examiner's Answer.

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12. Claims 1, 3-9, 12, 14-20, 23, 26-29, 37, 38, 43, 58, 61-64, 66, 70, 71, 73, 74, 76-79, and 81 are rejected under 35 U.S.C. 103(a) as being unpatentable over the cited Gillies patent in view of the cited Ott patent, as set forth in section VII, page 8 of the Examiner's Answer.

13. Claims 10, 11, 21, 22, and 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over the cited Gillies patent in view of the cited Ott patent, as applied to claims 1, 12, and 51 above, as set forth in section VIII, page 9 of the Examiner's Answer.

14. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over the cited Gillies patent in view of the cited Ott patent, as applied to claim 23 above, and in further view of the cited Lefkowitz patent and US 4,128,686 issued to Kyle et al., as set forth in section IX, page 10 of the Examiner's Answer.

15. Claims 40 and 82 are rejected under 35 U.S.C. 103(a) as being unpatentable over the cited Gillies patent in view of EP 261 904 issued to Taylor, as set forth in section X, page 10 of the Examiner's Answer.

16. Claims 24 and 72 are rejected under 35 U.S.C. 103(a) as being unpatentable over the cited Gillies patent in view of the cited Ott patent, as applied to claims 23 and 70 above, and in further view of EP 261 904 issued to Taylor, as set forth in section X, page 10 of the Examiner's Answer.

17. Claims 31, 44, 45, 52, 67, and 85 are rejected under 35 U.S.C. 103(a) as being unpatentable over the cited Gillies patent in view of the cited Sternlieb patent, as set forth in section XI, page 11 of the Examiner's Answer.

18. Claims 2, 13, 59, 60, and 75 are rejected under 35 U.S.C. 103(a) as being unpatentable over the cited Gillies patent in view of the cited Ott patent, as applied to claims 1, 12, 58, and 70

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above, and in further view of the cited Sternlieb patent, as set forth in section XI, page 11 of the Examiner's Answer.

19. Claims 1-23, 25-39, 41-71, 73-81, and 83-87 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 4,128,686 issued to Kyle et al. in view of the cited Gillies, Ott, and/or Sternlieb patents, as set forth in section XII, page 11 of the Examiner's Answer.

20. Claims 24, 40, 72, and 82 are rejected under 35 U.S.C. 103(a) as being unpatentable over the cited Kyle patent in view of the cited Gillies, Ott, and/or Sternlieb patents, as applied to claims 23, 39, 70, and 80 above, and in further view of the cited Taylor patent, as set forth in section XIII, page 12 of the Examiner's Answer.

Regarding the 103 obviousness rejections, applicant relies upon the traversal of the Sternlieb, Lefkowitz, Ott, and Gillies anticipation rejections (Amendment, section 5, page 27). Since applicant's traversal of said anticipation rejections has been found unpersuasive, the obviousness rejections have been maintained for the reasons of record.

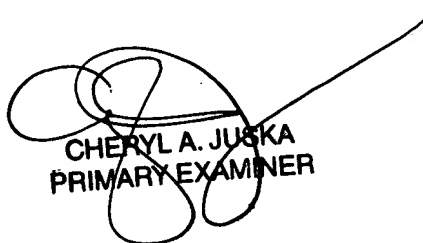
### *Conclusion*

21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheryl Juska whose telephone number is 571-272-1477. The examiner can normally be reached on Monday-Friday 10am-6pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached at 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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22. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



CHERYL A. JUSKA  
PRIMARY EXAMINER

cj  
August 1, 2005